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EXAMINER

WALLERSON, MARK E

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 07/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/383,981	<b>Applicant(s)</b> HAYWOOD ET AL.	
	<b>Examiner</b> Mark E. Wallerson	<b>Art Unit</b> 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-12,14-18 and 20-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,3-7,9-12,14-18 and 20-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

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### **Part III DETAILED ACTION**

#### ***Notice to Applicant(s)***

1. This action is responsive to the following communications: amendment filed on **2/23/05**.
2. This application has been reconsidered. Claims 1, 3-7, 9-12, 14-18, and 20-29 are pending.

#### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 6, 7, 9, 26, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teng et al (Teng) in view of Savitzky (U.S. 6,012,083).

With respect to claims 1, 6, 26, and 27, Teng discloses a method for submitting a document in electronic form from a computer (20) to a service bureau (50) for printing, comprising: displaying on the computer printer properties (column 7, line 61 to column 8, line 1), receiving a print command input to the computer (column 4, lines 45-51) for printing at the service bureau (50) a document stored in memory accessible to the computer wherein the print command includes user individualized instructions (column 5, lines 44-55); responsive to the print command, routing the document over Internet from the computer to the service bureau for printing (column 5, lines 44-63), comprising automatically activating a communications program (applications process) in the computer upon selection of the print command (column 6, lines 1-42), and transmitting the document from the computer to a server (49) associated with the service

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bureau (column 6, lines 22-62 and column 2, lines 55-62) and providing accessibility to the document by the computer without communication between the computer and the service bureau (column 7, lines 35-60).

Teng differs from claims 1 and 26 in that he does not clearly disclose displaying plural printer routing options.

Savitzky discloses a method for document processing wherein which gives a user the option to select a printer by presenting the user with a Web page showing printer locations and a clickable map of the printers (column 13, lines 15-28). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Teng wherein a user is presented with various printer to select from. It would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Teng by the teaching of Savitzky in order to improve the user flexibility of the system as disclosed by Savitzky in column 2, lines 44-45.

With regard to claim 7, Teng discloses the applications program is a multimedia program (column 7, lines 35-55).

With respect to claim 9, Teng discloses the printer is a direct networked printer (50).

With respect to claim 27, Teng discloses operating the Internet print request while an application is active during operation (column 6, lines 1-42).

5. Claims 3, 5, 10, 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teng in view of Savitzky as applied to claims 1 and 26 above, and further in view of Tonkin (U.S. 6,134,568).

With regard to claim 3, Teng as modified does not clearly disclose retrieving a print web page from the server, the print web page including information identifying plural print job options; displaying the print web page on the computer, the web page including a print job order form; and responsive to a user selection of one or more print job options identified on the print job order form, transmitting the print job order form to the service bureau. However, Tonkin discloses retrieving an Internet print web page (facility's home web page) from the server (processing facility reads on the server; col. 5, lines 53-col. 6, lines 1-8), the Internet print web page including information identifying plural print job options (col. 7, lines 12-65), displaying the Internet print web page (facility's home web page) on the computer (remote terminal reads on the computer, col. 5, lines 39-67), the Internet web page including a print job order form (col. 13, lines 25-51), and responsive to a user selection of one or more print job options identified on the print job order form, transmitting the print job order form to the service bureau (col. 13, lines 13-41 ).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Tonkin due to the references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

With respect to claim 5, Teng discloses the print job options include service bureau location (column 6, lines 22-25).

With regard to claim 10, Teng as modified does not clearly disclose receiving an acknowledgment that the document has been submitted to the service bureau for printing.

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However, Tonkin discloses receiving an acknowledgment that the document has been submitted to the service bureau for printing (col. 14, lines 24-29).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Tonkin due to the references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

With respect to claim 28, Teng as modified does not disclose the storage medium wherein instructions for operating the Internet print request while an application is active comprises instructions defining at least one of a word processing program, a database program, a graphics program, or a multimedia program. However, Tonkin discloses the storage medium wherein instructions for operating the Internet print request while an application is active comprises instructions defining at least one of a word processing program, a database program, a graphics program (evident in Java applet), or a multimedia program (col. 5, lines 39-52).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Tonkin due to the references disclosing Internet printing systems to allow a user to preview a document prior to assembly to prevent any miscommunication problems that may arise.

6. Claims 23 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teng in view of Savitzky as applied to claims 1 and 26 above, and further in view of Shiohara (U.S. Patent Publication No. 2003/0011806 A1).

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With regard to claim 23, Teng as modified does not clearly disclose the printer destinations are selected from at least one of an Internet print shop printer, local network printers and direct network printers. However, Shiohara discloses the method wherein the printer destinations are selected from at least one of an Internet print shop printer, local network printers (the network connection section 29 to the selected printer reads on local network printers) and direct network printers (paragraphs 54-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Shiohara due to the references disclosing selection of plural printers to provide a system for generating print data in a manner compatible for use by a plurality of printers in a printing system.

With respect to claim 29, Teng as modified does not clearly disclose the storage medium wherein the set of program instructions further comprises instructions for selecting an appropriate printer driver that includes at least one of an Internet print shop printer, local network printer, and direct network printer.

However, Shiohara discloses the storage medium wherein the set of program instructions further comprises instructions for selecting an appropriate printer driver that includes at least one of an Internet print shop printer, local network printer (the network connection section 29 to the selected printer reads on local network printers) and direct network printers (paragraphs 54-55). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Shiohara due to the references disclosing selection of plural printers to provide a system for generating print data in a manner compatible for use by a plurality of printers in a printing system.

7. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teng in view of Savitzky as applied to claim 1 above, and further in view of Cheng (U.S. 6,012,070).

With regard to claim 4, Teng as modified does not clearly disclose the server is an intermediary server, and transmitting the print job order form includes transmitting the print job order form by the way of the server to a server of the service bureau.

However, Cheng discloses the method wherein the server is an intermediary server, and transmitting (transmission) the print job order form (print order contracts read on print job order form) includes transmitting (transmission) the print job order form (print order contracts) by the way of the server (server station 100) to a server (customer service station 105) of the service bureau (production station 106 reads on the service bureau; col. 9, lines 44-col. 11, lines 1-11). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Cheng due to all references disclosing an Internet printing system to allow simple yet professional looking creation of customized business forms or brochures and provide transmission of those forms or brochures to a printing facility.

8. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Teng in view of Savitzky as applied to claim 1 above, and further in view of Bellucco (U.S. 5,524,085).

With regard to claim 11, Teng as modified does not clearly disclose the method wherein the document includes multimedia content. However, Bellucco discloses the method wherein the document includes multimedia content (col. 4, lines 23-col. 5, lines 1-14).



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Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Teng as modified and Bellucco due to the references disclosing printing systems to provide additional space with a job ticket containing special instructions.

9. Claims 12, 15-18, 21, 22, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin in view of Shiohara and Savitzky.

Regarding claim 12, Tonkin discloses a computing machine comprising: a computer (remote terminal) controlled by software modules (inherent in client terminal having software modules', col. 5, lines 28-col. 6, lines 1-20), a first module (inherent in processing facility 16) to sense an Internet print request (monitors for requests reads on sense an Internet print request', col. 5, lines 39-67), and a second module (inherent in processing facility 16) to automatically launch a communications program ("an initial document creation window and a Java applet which can be executed on a remote terminal to enable a user to preview a specified document" reads on automatically activating a communication browser program', col. 5, lines 39-col. 6, lines 1-20) module (document creation window) to access a server (60) associated with both (col. 3, lines 40-col. 4, lines 1-24) a service bureau at a predefined address (processing facility routes a message addressed to that document production location reads on predefined message', col. 3, lines 41-col. 4, lines 1-24) or an intermediary (processing facility 60 reads on intermediary; col. 3, lines 40-col. 4, lines 1-24), the server providing a browser with a print order form (col. 5, lines 39- col. 6, lines 1-20); a third module (graphical user interface) to display the print order form (order information reads on the print order form; col. 6, lines 1-63), and a fourth module

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(inherent in processing facility 16) to transmit user individualized print order data and a document to be routed from the computer to the server providing the browser with the print order form (col. 6, lines 1- 63 and column 3, line 57 to column 4, line 5).

Although Tonkin does not specifically disclose the computer controlled by modules selects the appropriate printer destinations, Shiohara discloses wherein the computer (personal computer) controlled by modules (execution modules read on modules) selects the appropriate printer destinations (listed printers based on print contents and so on read on the appropriate printer destinations; paragraph 47 and paragraphs 72-73).

Although Tonkin and Shiohara do not disclose the first module displaying plural printer routing options, Savitzky discloses the first module displaying (showing) plural printer routing options (printer locations read on plural printer routing options), one of the printer routing options (printer locations) being the Internet print request (requests an HTML document to be printed on printer reads on Internet print request', col. 13, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Shiohara, and Savitzky due to all of the references disclosing Internet printing systems to allow for general agent execution at a locus specified by the user independently of the server or client which might be used.

Regarding claim 18, Tonkin discloses a computer readable medium to control a computer and having modules stored therein, the media comprising: a first module (inherent in processing facility 16) to sense an Internet print request (monitors for requests reads on sense an Internet print request, col. 5, lines 39-67), and a second module (inherent in processing facility 16) to launch a communications program ("an initial document creation window and a Java applet

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which can be executed on a remote terminal to enable a user to preview a specified document" reads on automatically activating a communication browser program', col. 5, lines 39-col. 6, lines 1-20) module (document creation window) to access a server (inherent within the document g: production location) associated with both (col. 3, lines 40-col. 4, lines 1-24) a service bureau at a predefined address (processing facility routes a message addressed to that document production location reads on predefined message, col. 3, lines 41-col. 4, lines 1-24) or an intermediary (processing facility 60 reads on intermediary; col. 3, lines 40- col. 4, lines 1-24), the server providing a browser with a print order form (col. 5, lines 39- col. 6, lines 1-20), a third module (graphical user interface) to display the print order form (order information reads on the print order form', col. 6, lines 1-63), and a fourth module (inherent in processing facility 16) to transmit print order data and a document to be routed from the computer to the server providing the browser with the print order form (col. 6, lines 1- 63 and column 3, line 57 to column 4, line 5).

Although Tonkin does not specifically disclose the computer controlled by the modules selects the appropriate printer destination, Shiohara discloses wherein the computer (personal computer) controlled by the modules (execution modules read on modules) selects the appropriate printer destination (listed printers based on print contents and so on read on the appropriate printer destinations', paragraph 47 and paragraphs 72-73).

Although Tonkin and Shiohara do not disclose the first module displaying plural printer routing options, Savitzky discloses the first module displaying (showing) plural printer routing options (printer locations read on plural printer routing options), one of the printer routing

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options (printer locations) being the Internet print request (requests an HTML document to be printed on printer reads on Internet print request; col. 13, lines 1-28).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Shiohara, and Savitzky due to all of the references disclosing Internet printing systems to allow for general agent execution at a locus specified by the user independently of the server or client which might be used.

Regarding claim 15, Tonkin and Savitzky do not disclose the first module is for sensing print requests for direct networked printers. However, Shiohara discloses the first module (print request router 26 reads on first module) is for sensing print requests (print request reads on print requests) for direct (see Fig. 2) networked (network connection section 29) printers (printers read on printers; paragraph 28 and paragraphs 47-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Shiohara, and Savitzky due to all of the references disclosing Internet printing systems to allow for general agent execution at a locus specified by the user independently of the server or client which might be used.

Regarding claim 16, Tonkin discloses the machine further comprising an applications module (graphical user interface) which is active when during operation of said first and second modules (col. 6, lines 22-col. 7, lines 1-11).

Regarding claim 22, Tonkin discloses the computer readable medium the applications module can be any one of a word processing program, a database program, a graphics program (Java applet), or a multimedia program (col. 5, lines 39- 52).

Regarding claim 24, Tonkin and Savitzky do not disclose the machine wherein the printer destinations are selected from at least one of an Internet print shop printer, local network printers and direct network printers. However, Shiohara discloses the method wherein the printer destinations are selected from at least one of an Internet print shop printer, local network printers (the network connection section 29 to the selected printer reads on local network printers) and direct network printers (paragraphs 54-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Savitzky, and Shiohara due to all of the references disclosing Internet printing systems to provide a system for generating print data in a manner compatible for use by a plurality of printers in a printing system.

Regarding claim 25, Tonkin and Savitzky do not disclose the machine wherein the printer destinations are selected from at least one of an Internet print shop printer, local network printers and direct network printers. However, Shiohara discloses the method wherein the printer destinations are selected from at least one of an Internet print shop printer, local network printers (the network connection section 29 to the selected printer reads on local network printers) and direct network printers (paragraphs 54-55).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Savitzky, and Shiohara due to all of the references disclosing Internet printing systems to provide a system for generating print data in a manner compatible for use by a plurality of printers in a printing system.

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Regarding claim 17, Tonkin discloses the machine wherein the applications module can be any one of a word processing program, a database program, a graphics program (Java applet), or a multimedia program (col. 5, lines 39-52).

Regarding claim 21, Tonkin discloses the computer readable medium further comprising an applications module (graphical user interface) which is active when during operation of said first and second modules (col. 6, lines 22-col. 7, lines 1-11).

10. Claims 14 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin, Shiohara, and Savitzky as applied to claims 12 and 18 above, and further in view of Bellucco

Regarding claim 14, Tonkin, Shiohara, and Savitzky do not disclose the document to be printed includes multimedia content. However, Bellucco discloses a document to be printed includes multimedia content (col. 4, lines 23- to column lines 1-14). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Shiohara, Savitzky, and Bellucco due to the references disclosing printing systems to provide additional space with a job-ticket containing special instructions.

Regarding claim 20, Tonkin, Shiohara, and Savitzky do not disclose the computer readable medium wherein the document to be printed includes multimedia content.

However, Bellucco discloses the computer readable medium wherein the document to be printed includes multimedia content (col. 4, lines 23-col. 5, lines 1-14). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made would combine the teachings of Tonkin, Shiohara, Savitzky, and Bellucco due to the references

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disclosing printing systems to provide additional space with a job-ticket containing special instructions.

***Response to Arguments***

11. Applicant's arguments with respect to claims 1, 12, 18, and 26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

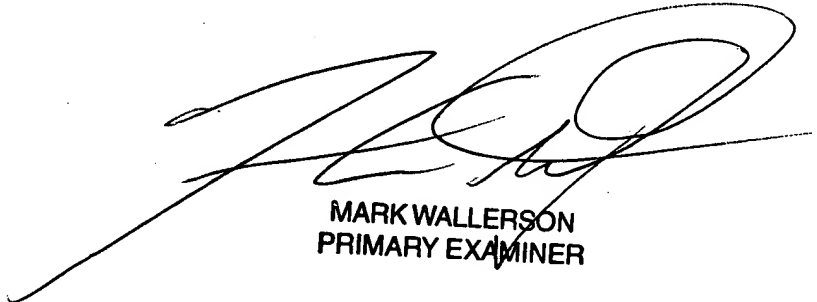
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (571) 272-7470. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626



MARK WALLERSON  
PRIMARY EXAMINER